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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/659,175	09/10/2003	Katsumi Sasaki	P/3541-42	7479
2352	7590	06/01/2006	EXAMINER	
OSTROLENK FABER GERB & SOFFEN 1180 AVENUE OF THE AMERICAS NEW YORK, NY 100368403				STINSON, FRANKIE L
		ART UNIT		PAPER NUMBER
		1746		

DATE MAILED: 06/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/659,175	SASAKI ET AL.	
	Examiner	Art Unit	
	FRANKIE L. STINSON	1746	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 14 April 2006.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) 4-9 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1,2,10,14 and 18 is/are rejected.
- 7) Claim(s) 3,11-13 and 15-17 is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____.

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1. Claims 1-3 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Re claim 1, at the last two lines, the phrase "the cleaning water" is without proper antecedent basis.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 2, 10, 14 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over either Rollins (U. S. Pat. No. 582,148).

Re claim 1, Rollins discloses a cleaning device for an instrument, comprising:

a tubular member (E) including a proximate-end portion and a distal-end portion the distal end portion intended to be inserted in an inlet of a channel of the instrument; a first water supply outlet (as at e³) formed in the distal-end portion of the tubular member and which leads to the channel to supply cleaning water to the channel, when the distal-end portion is inserted in the inlet of the channel;

a seal member (e) which is disposed on an outer periphery of the distal-end portion of the tubular member and which is positioned upstream from the first water supply outlet to seal a gap between an outer peripheral portion of the distal-end portion and an inner surface of the channel and to constitute an engaging portion which

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attaches the distal-end portion inserted in the inlet of the channel to the instrument, when the distal-end portion is inserted in the inlet;

a second water supply outlet (e^9) formed in the tubular member and positioned upstream from the seal member and

a water inlet (e^8) which is formed in the proximate-end portion of the tubular member and which is connectable to a water supply that differs from the claim only in the recitation of the device for cleaning and for cleaning a medical instrument. As for the cleaning process, it should be noted that Rollins fails to specifically disclose the device for cleaning, however, in view of the fact that Rollins employs water, cleaning would automatically be inherent. As for cleaning a medical instrument, the same has been deemed to be of little patentable significance in that the body of the claim fails to recite any limitations that would limit the device for cleaning medical instruments only.

Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than function. *In re Danly*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). “ [A]pparatus claims cover what a device is, not what a device does.” *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990). (emphasis in original). Re claim 2, Rollins discloses the engagement portion (c^1). Re claim 10, Rollins discloses the seal (c^2) as claimed. Re claims 14 and 18, Rollins discloses the second outlet and water inlet arranged as claimed.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1 and 10 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Krause (U. S. Pat. No. 1,402,504).

Re claim 1 for example, Krause is cited disclosing a cleaning device for an instrument, comprising:

a tubular member (6) including a proximate-end portion and a distal-end portion the distal end portion intended to be inserted in an inlet of a channel of the instrument;

a first water supply outlet (as at 16) formed in the distal-end portion of the tubular member and which leads to the channel to supply cleaning water to the channel, when the distal-end portion is inserted in the inlet of the channel;

a seal member (7) disposed on the lower/distal end see fig. 1) which is disposed on an outer periphery of the distal-end portion of the tubular member and which is positioned upstream from the first water supply outlet to seal a gap between an outer peripheral portion of the distal-end portion and an inner surface of the channel and to constitute an engaging portion which attaches the distal-end portion inserted in the inlet of the channel to the instrument, when the distal-end portion is inserted in the inlet;

a second water supply outlet (15) formed in the tubular member and positioned upstream from the seal member and

a water inlet (not shown) which is formed in the proximate-end portion of the tubular member and which is connectable to a water supply of cleaning water as for the recitation of the device for cleaning a medical instrument, the same has been deemed

to be of little patentable significance in that the body of the claim fails to recite any limitations that would limit the device for cleaning medical instrument only.

Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than function. *In re Danly*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). “ [A]pparatus claims cover what a device is, not what a device does.” *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990). (emphasis in original). Re claim 10, Krause discloses the seal (upper element 7).

2. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Krause in view of Clapp et al. (U. S. Pat. No. 4,799,554).

Claim 2 defines over Krause only in the recitation of the engagement portion. Clapp is cited disclosing the engagement portion (as at 21, see fig. 1) as claimed. It therefore would have been obvious to one having ordinary skill in the art to modify the device of Krause, to include an engagement portion as taught by Clapp, for the purpose of supporting the device thereby preventing any chafing damage to the device.

3. Claims 3, 11-13 and 15-17 stand objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

4. Claims 4-9 stand allowed.

5. Applicant's arguments with respect to the pending claims have been considered but are moot in view of the new ground(s) of rejection.

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to FRANKIE L. STINSON whose telephone number is (571) 272-1308. The examiner can normally be reached on M-F from 5:30 am to 2:00 pm and some Saturdays from approximately 5:30 am to 11:30 am.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Barr, can be reached on (571) 272-1700. The fax phone number for the organization where this application or proceeding is assigned is 571-272-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

fls



FRANKIE L. STINSON
Primary Examiner
GROUP ART UNIT 1746